

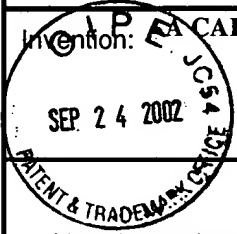
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CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10), Applicant(s): Mellardo	Docket No. Mellardo-1 CPA
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Serial No. 09/295,212	Filing Date 4/21/99	Examiner William H. Mayo III	Group Art Unit 2831
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Invention: CABLES ARRESTER, IN COMBINATION WITH AN ENERGIZED FLUID CONDUIT



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TRANSMITTAL OF APPEAL BRIEF (Large Entity)

Docket No.
Mellardo-1 CPA

Application Of: **Mellardo**

Serial No.	Filing Date	Examiner	Group Art Unit
09/295,212	4/21/99	William H. Mayo III	2831

Invention: **A CABLES ARRESTER, IN COMBINATION WITH AN ENERGIZED FLUID CONDUIT**

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on

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- ☒ A check in the amount of the fee is enclosed.
- ☐ The Commissioner has already been authorized to charge fees in this application to a Deposit Account. A duplicate copy of this sheet is enclosed.
- ☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. **50-2061**
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Signature

Dated: 9/24/02

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#17 / Appeal
Brief
DEVALS
9-27-02

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of: Mellardo	Examiner: William H. Mayo, III
Serial No.: 09/295,212	Group Art Unit: 2831
Filed: 4/21/99	Docket No.: Mellardo-1 CPA
For: A CABLE ARRESTER, IN COMBINATION WITH AN ENERGIZED FLUID CONDUIT	Date: September 24, 2002
	<p>I CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE U.S. POSTAL SERVICE "EXPRESS MAIL" IN AN ENVELOPE ADDRESSED TO COMMISSIONER FOR PATENTS, WASHINGTON, DC 20231</p> <p align="center"><u>9-24-02</u></p> <p align="center">_____ Susan Barlett</p>

Commissioner for Patents
Washington, D.C. 20231

Sir:

BRIEF OF APPELLANT

This is an appeal from the Office action mailed on May 21, 2002 finally rejecting claims 1-9, all the claims pending in the application. This Brief is accompanied by the requisite fees set forth in 37 CFR 1.17(c). Authorization is hereby given for any additional fees due and owing in connection with this Brief or for any overpayment credit to be charged to Deposit Account No.50-2061.

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REAL PARTY IN INTEREST

ITT Industries, Inc. is the real party in interest in the present appeal.

RELATED APPEALS AND INTERFERENCES

ITT Industries, Inc., the real party in interest in the above-captioned application, has no related applications currently on appeal or involved in an interference.

STATUS OF CLAIMS

Claims 1-9 stand finally rejected.

STATUS OF AMENDMENTS

No amendments have been filed subsequent to the final rejection mailed on May 21, 2002.

SUMMARY OF THE INVENTION

The invention relates to a combination cables arrester and energized-fluid conduit. Referring to FIG. 1 and page 2, lines 19-30, the combination cables arrester and energized-fluid conduit comprises a vertically disposed conduit 10 that conducts an energized fluid, such as water, therethrough from entry 12 of the conduit 10 to a discharge outlet or pipe 14. The entry 12 of the conduit 10 is fastened to an electrically powered axial flow pump 16. A plurality of sheathed power cables 18, each comprising a cable 30 confined in a jacketing sheath 32 (FIGS. 2 and 3, and page 3 lines 10-11), extend through the conduit 10 and connect to the pump 16. The cables 18 are held in a spaced-apart disposition across the conduit by a cables arrester 20.

Referring to FIGS. 2 and 3 and page 3, lines 1-31, the cables arrester 20 comprises a platform 22 with opposite ends that engage brackets 28. The brackets 28 include fasteners that removably fix the brackets 28 to the wall surface of the conduit 10. The platform 22 also has apertures that receive internally-threaded pipe couplers 24 and 26. Fittings 34 at the ends of each sheath 32 of each cable 18, threadedly engage their respective pipe coupler 24, 26 or an internally threaded hollow stanchion, 36 attached to the pump 16. Strain relief devices 38 and 40 threadedly engage respective ones of the pipe couplers 24 and 26, at the top of the arrester 20. The strain relief devices 38 and 40 comprise grips, which when tightened, prevent the cables from slipping through their respective pipe couplers 24 and 26.

ISSUES

The issue in this appeal is whether claims 1-9 are unpatentable under 35 USC §103(a) over U.S. Patent 4,913,239 to Bayh, III in view of U.S. Patent 4,483,395 to Kramer *et al.*

GROUPING OF CLAIMS

Claims 1, 2, 3, and 5 stand or fall together.

Claims 4, 6, and 9 stand or fall together.

Claim 7 stands or falls alone.

Claim 8 stands or falls alone.

ARGUMENTS

I. REJECTION UNDER 35 USC §103(a) **USING BAYH IN VIEW OF KRAMER**

The issue in this appeal is whether claims 1-9 are unpatentable under 35 USC §103(a) over U.S. Patent 4,913,239 to Bayh, III (Bayh) in view of U.S. Patent 4,483,395 to Kramer *et al.* (Kramer).

Group of claims 1, 2, 3, and 5:

Independent claim 1 pertains to a combination cables arrester and energized-fluid conduit and reads as follows:

A cables arrester, in combination with an energized-fluid conduit,
comprising:

a conduit having a wall surface, the conduit for conducting an energized
fluid therethrough;

a plurality of power cables confined within said conduit; and

means removably fixed to said wall surface within said conduit for
holding said plurality of cables in spaced-apart disposition across said
conduit.

In support of the rejection, the examiner contends that the production tubing string 20 described in Bayh is the claimed energized-fluid conduit and that the electrical connector 45 described in Bayh is the claimed means for holding power conductors in a spaced apart disposition across the conduit. The examiner further contends that the differences between Bayh

and the invention of claim 1 lies in the fact that the electrical connector 45 in Bayh is not removably fixed to the wall surface of the tubing string 20.

To overcome the deficiency in Bayh, the examiner relies on the wire guard 10 described in Kramer stating in section 2 of the Office action that:

it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the bridging means of Bayh, III to comprise the bridging means as taught by Kramer because Kramer teaches that such a configuration provides protection from abrasion against the inner surfaces of the conduit and provides a simple and inexpensive construction that functions in a more efficient manner than any comparable device.

and further stating in section 3 of the Office action that:

it would have been obvious to modify Bayh to comprise a connector being removably fixed to the wall surface of the conduit, in order to provide the conductors of Bayh with protection from abrasion against the inner surfaces of the conduit, wherein the configuration as taught by Kramer's simple and inexpensive and functions in a more efficient manner than any comparable device, such as Bayh's connector.

Hence, it appears to be the examiner's position that one of ordinary skill in the art would have been motivated at the time of invention to replace the electrical connector in Bayh with the wire guard taught by Kramer.

A claimed invention is *prima facie* obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings. See *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. See *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Third, the

prior art reference or combined references must teach or suggest all the claim limitations. *See In re Royka*, 490 F. 2d 981, 180 USPQ 580 (CCPA 1974).

The examiner has failed to establish a *prima facie* case of obviousness of the invention of claim 1 because there is no motivation for combining the teachings of Bayh and Kramer in the manner proposed by the examiner. The electrical connector 45 disclosed in Bayh provides a mechanical link between the cable anchor assembly 40 and the locking module assembly 60, and an electrical link between the power cable 30 and the electric motor 50. (column 6, lines 45-57). The wire guard 10 taught by Kramer is not capable of mechanically linking the cable anchor assembly 40 and the locking module assembly 60 or electrically linking the power cable 30 and the electrical motor 50. Hence, replacing the electrical connector 45 of Bayh with the wire guard 10 of Kramer would render the Bayh system inoperable for its intended purpose. It is well settled in the law that a proposed modification that would render a reference unsatisfactory or inoperable for its intended purpose is not supported by motivation. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Notwithstanding that the examiner's modification of the Bayh system renders it inoperable, there is still no motivation for modifying Bayh with the wire guard of Kramer. Contrary to the examiner's overly broad comparison of Bayh and Kramer in paragraph 1 of section 4 of the Office action, Bayh and Kramer do not describe the same type of conduits. The Bayh electrical connector 45 is utilized in a tubing string 20 that conducts energized fluids whereas the Kramer wire guard is utilized in a well casing 12, that does not conduct energized fluids. In addition, the Kramer wire guard utilizes a light duty fastening arrangement formed by a plurality of radially projecting tabs 32 that engage the wall surface of the well casing 12. Such a fastening arrangement does not appear useable in conduits that conduct energized fluids

because the forces of the passing fluids are likely to dislodge the tabs 32 from the surface of an energized-fluid conduit. Accordingly, it is unlikely that one of ordinary skill in the art at the time of invention would have been motivated to substitute the Kramer wire guard for the electrical connector employed in the energized-fluid tubing string of Bayh.

The examiner argues in section 4, paragraph 2 of the Office action that the test for obviousness is not whether the features of a secondary reference may be “bodily incorporated” into the structure of the primary reference. However, the examiner’s proposed modification of Bayh using Kramer, e.g., “modify the bridging means of Bayh, III to comprise the bridging means as taught by Kramer,” amounts to nothing more than a bodily incorporation of Kramer’s wire guard in the device of Bayh.

In view of the foregoing, claims 1, 2, 3, 5, and 8 are not unpatentable under 35 USC §103(a) over Bayh in view of Kramer.

Group of claims 4, 6, and 9:

Dependent claims 4, 6, and 9 recite additional features which further distinguish over Bayh in view of Kramer. For example, dependent claim 4 reads as follows:

A cables arrester, according to claim 2, wherein:

said bridging means comprises an apertured platform, threaded pipe couplers in fixed alignment with apertures in said platform, and brackets for removably fixing said platform across said conduit.

The examiner states in section 2, paragraph 1 of the Office action, with respect to claim 4 that:

Bayh, III discloses that the bridging means comprises an aperture platform (Fig. 6), threaded pipe couplers (bottom of Fig. 2A), which are in fixed alignment with the apertures (where the power conductors are

located) and brackets (37, 38) for removably fixing the platform (Fig 6) across the conduit (20, Col. 4, lines 1-4).

It is not understood how the examiner can now rely upon the Bayh electrical connector 45 and its locking rings 37 and 38 to reject claim 4 when the examiner rejects the subject matter of claim 1, by replacing the electrical connector 45 of Bayh with the wire guard 10 of Kramer.

Moreover, the examiner's characterization of Bayh is inconsistent in the Office action. For example, section 2, paragraph 2 of the Office action states that "Bayh, III doesn't necessarily disclose that the means is removably fixed to the wall surface of the conduit." This statement is inconsistent with the examiner's statement quoted immediately above.

In any case, the examiner has failed to establish a *prima facie* case of obviousness of the invention of claim 4 because there is no motivation for combining the teachings of Bayh and Kramer in the manner proposed by the examiner, and Bayh in view of Kramer fail to teach or suggest the claim limitations of claim 4. Regarding the lack of motivation for combining Bayh and Kramer, the arguments set forth with respect to claims 1, 2, 3, 5, and 8 are incorporated herein by reference.

Regarding the failure of Bayh in view of Kramer to teach or suggest the claim limitations of claim 4, Bayh in view of Kramer fail to teach or suggest threaded pipe couplers in fixed alignment with apertures in the platform, and brackets for removably fixing the platform across the conduit. Bayh in view of Kramer, as proposed by the examiner in section 2, paragraph 4 of the Office action, merely teach the substitution of the Kramer wire guard for the electrical connector of Bayh. The Kramer wire guard does utilize nor require a threaded pipe coupler because it employs a pipe coupler formed by a cylindrical inner ring 21 having a split 23 and a

hinge 24, which together, allow the ring to be open and closed, and locking elements 34 and 37 with cooperating locking teeth 35 and 38 that lock the ring 21 in the closed position.

In view of the foregoing, claims 4, 6, and 9 are not unpatentable under 35 USC §103(a) over Bayh in view of Kramer.

Group of claim 7:

Dependent claim 7 recites additional features which further distinguish over Bayh in view of Kramer. Dependent claim 7 reads as follows:

A cables arrester, according to claim 1, further including:

means engaged with said cables of said plurality thereof for strain-relieving said cables.

The examiner states in section 2, paragraph 1 of the Office action, with respect to claim 7 that:

Bayh, III discloses that there exist a means (128, 129, & 130) engaged with the power conductors (88, 89, & 90) for strain relieving the conductors (Col. 6, lines 52-57).

It is not understood how the examiner can now rely upon the Bayh electrical connector 45 and its electrical penetrators 128, 129, & 130 to reject claim 7 when the examiner rejects the subject matter of claim 1, by replacing the electrical connector 45 of Bayh with the wire guard 10 of Kramer.

In any case, the examiner has failed to establish a *prima facie* case of obviousness of the invention of claim 7 because there is no motivation for combining the teachings of Bayh and Kramer in the manner proposed by the examiner, and Bayh in view of Kramer fail to teach or

suggest the claim limitations of claim 7. Regarding the lack of motivation for combining Bayh and Kramer, the arguments set forth with respect to claims 1, 2, 3, 5, and 8 are incorporated herein by reference.

Regarding the failure of Bayh in view of Kramer to teach or suggest the claim limitations of claim 7, Bayh in view of Kramer fail to teach or suggest means for strain-relieving the cables. The electrical penetrators 128, 129, 130 relied upon by the examiner appear to function as electrical contacts for the electrical conductors 88, 89, and 90. There is no disclosure in Bayh that electrical penetrators function to strain-relieve the conductors.

Moreover, the examiner states that the electrical penetrators are the power cables recited in claim 8. The electrical penetrators can not be both elements.

In view of the foregoing, claim 7 is not unpatentable under 35 USC §103(a) over Bayh in view of Kramer.

Group of claim 8:

Dependent claim 8 recites additional features which further distinguish over Bayh in view of Kramer. Dependent claim 8 reads as follows:

A cables arrester, according to claim 1, further including:

means for energizing fluid within said conduit; and wherein said cables are coupled to said fluid energizing means.

The examiner states in section 2, paragraph 1 of the Office action, with respect to claim 8 that:

Bayh, III discloses that there exist a means (70, i.e. pump) in the form of control devices for energizing the fluid with the conduit (20) and wherein cables (128, 129, & 130) are coupled to the control devices (Col. 4, lines 9-11).

The examiner has failed to establish a *prima facie* case of obviousness of the invention of claim 8 because there is no motivation for combining the teachings of Bayh and Kramer in the manner proposed by the examiner, and Bayh in view of Kramer fail to teach or suggest all the claim limitations of claim 8. Regarding the lack of motivation for combining Bayh and Kramer, the arguments set forth with respect to claims 1, 2, 3, 5, and 8 are incorporated herein by reference.

Regarding the failure of Bayh in view of Kramer to teach or suggest all the claim limitations of claim 8, Bayh in view of Kramer fail to teach or suggest the claimed power cables coupled to the fluid energizing means. The electrical penetrators 128, 129, and 130 relied upon by the examiner are not the same elements (i.e., the electrical conductors 88, 89, and 90) relied upon by the examiner to reject the power cable elements introduced in claim 1 and now referred to in claim 8.

Moreover, the examiner states that the electrical penetrators are the strain-reliever means recited in claim 7. The electrical penetrators can not be both elements.

In view of the foregoing, claim 8 is not unpatentable under 35 USC §103(a) over Bayh in view of Kramer.

II. CONCLUSION

It has been shown that the claimed invention distinguishes over the express and implied teachings of the prior art cited of record in the application, and in particular, distinguishes over

the express and implied teachings of Bayh in view of Kramer. Hence, the appellant respectfully requests that the Board reverse the examiner and direct that the application proceed to issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'PA' followed by a stylized flourish.

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APPENDIX A
CLAIMS ON APPEAL

1. A cables arrester, in combination with an energized-fluid conduit, comprising:
a conduit having a wall surface, the conduit for conducting an energized fluid therethrough;
a plurality of power cables confined within said conduit; and
means removably fixed to said wall surface within said conduit for holding said plurality of cables in spaced-apart disposition across said conduit.
2. A cables arrester, according to claim 1, wherein:
said means comprises means bridging across an intermediate portion of said conduit.
3. A cables arrester, according to claim 2, wherein:
said bridging means comprises a platform, and conduit-engaging supports for said platform.
4. A cables arrester, according to claim 2, wehrein:
said bridging means comprises an apertured platform, threaded pipe couplers in fixed alignment with apertures in said platform, and brackets for removably fixing said platform across said conduit.

5. A cables arrester, according to claim 1, wherein:
said cables are jacketed with sheathing.
6. A cables arrester, according to claim 4, wherein:
said cables are jacketed with sheathing;
said sheathing terminates in threaded pipe fittings; and
said pipe fittings are threadedly engaged with said pipe couplers.
7. A cables arrester, according to claim 1, further including:
means engaged with said cables of said plurality thereof for strain
-relieving said cables.
8. A cables arrester, according to claim 1, further including:
means for energizing fluid within said conduit; and wherein
said cables are coupled to said fluid energizing means.
9. A cables arrester, according to claim 5, further including:
an axial flow pump; and wherein
said sheathing terminates in threaded pipe fittings; and
said pump has a threaded pipe coupler in which threadedly to
receive a sheathing pipe fitting.